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EXAMINER				
CONSILVIO, MARK J				
ART UNIT		PAPER NUMBER		
2872				
NOTIFICATION DATE		DELIVERY MODE		
12/08/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/574,269

Applicant(s)

MATSUMOTO ET AL.

Examiner

Mark Consilvio

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5 and 8-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

Claims 1, 3-5, and 8 were previously rejected and claim 1 is newly amended. Claims 9-12 are newly added. Claims 2, 6, and 7 have been cancelled. Claims 1, 3-5, and 8-12 are currently pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, 8, and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiff (US Patent No. 4,815,689) in view of Galicia (US Patent Application Publication No. 2001/0000443).

With respect to claim 1, Schiff discloses an integrated mirror comprising: an inside mirror part (25) for reflecting an inside field of vision of behind a vehicle; an outside mirror part (24) for reflecting an outside field of vision of behind the vehicle; and coupling means (38) for coupling the inside mirror part and the outside mirror part so that their respective mirror faces are parallel (col. 2, lines 10-13), characterized in that the inside mirror part and the outside mirror part are arranged to reflect predetermined regions (B) of the inside field of vision and the outside field of vision, respectively, of behind the vehicle when seen from a virtual view point

determined in accordance with a driver's view point position determined using predetermined physique data (figs. 1-4). Schiff does not expressly disclose the inside mirror part and the outside mirror part are disposed at a height above the driver's view point position. However, Galicia discloses internal and external mirrors at a height even with the center rearview mirror which is generally understood in the art to be above a driver's view point (fig. 7). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to apply the known technique of raising the height of an auxiliary rearview mirror to achieve the claimed invention and one skilled in the art could have in the same way as Galicia and the modification would have yielded the predictable result of a higher vantage point reflected by the mirror.

With respect to claim 3, Schiff discloses attaching means (36) provided part-way along the coupling means and mounted rotatably in an upper part of the vehicle exterior part, and the inside mirror part and the outside mirror part move in linkage about the attaching means as a center of rotation (fig. 3 col. 3, lines 53-65).

With respect to claim 4, Schiff discloses the mirror position is adjusting by moving the inside part (col. 3, lines 53-65).

With respect to claim 5, Schiff discloses the vehicle exterior part is left and right front pillars (col. 2, lines 52-60).

With respect to claim 8, Schiff discloses the virtual view point is provided in front of the front pillar (since, by the principles of reflection, a virtual view point will be a point behind/beyond (i.e. in front of) the mirror and the mirror is positioned at the front pillar) and within a range of height from the ground to the vehicle height (figs. 1 and 4).

With respect to claim 10, the combination of Schiff and Galicia discloses or suggests all the limitations of claim 1 as stated *supra*. Schiff does not expressly disclose the inside mirror part and the outside mirror part have different shapes. However, Galicia teaches mirrors (11, 12) with different shapes in a similar configuration (c.g. fig. 7). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to choose any reasonable shapes for the mirrors (including differing shapes) since the courts have held that such minor features are a matter of design choice absent persuasive evidence that the particular configuration of the claimed invention was significant. See *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Further, changing the shape and, therefore, field of view of a mirror would have been readily predictable to one of ordinary skill.

With respect to claim 11, the combination of Schiff and Galicia discloses or suggests all the limitations of claims 1 and 3 as stated *supra*. Schiff does not expressly disclose the outside mirror part is coupled to the coupling means by a pivoting joint. However, Galicia teaches a similar mirror arrangement where the two mirrors are independently adjustable (par. 35). Such an arrangement is conventional in the art. Commonly, rearview mirrors are connected to their supporting structures via universal joints to allow the mirror to be adjusted for the height or positioning of a particular driver or to reflect the image of a particular scene or area. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the combination of Schiff and Galicia with an additional pivot joint between the mirror and coupling means to achieve the claimed invention because all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have

yielded predictable results. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950).

With respect to claim 12, the combination of Schiff and Galicia discloses or suggests all the limitations of claims 1 and 3 as stated *supra*. Schiff does not expressly disclose the attaching means is moveable up and down the vehicle exterior part so that the height of the inside mirror part and the outside mirror part is adjustable so as to be maintained in a position above the view point position of various drivers having different heights. However, Galicia teaches a similar arrangement of interior and exterior mirrors that are moveable up and down the vehicle exterior part so that the height of the inside mirror part and the outside mirror part is adjustable (figs. 11A and 11B). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to apply the known technique of vertical mirror adjustment to achieve the claimed invention and one skilled in the art could have in the same way as Galicia and the modification would have yielded predictable results. *Ruiz v. AB Chance Co.* 357 F.3d 1270, 69 USPQ2d 1686 (Fed. Cir. 2004).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiff (US Patent No. 4,815,689) in view of Galicia (US Patent Application Publication No. 2001/0000443) and in further view of Hou (US Patent No. 4,998,812).

With respect to claim 9, the combination of Schiff and Galicia discloses or suggests all the limitations of claim 1 as stated *supra*. The combination of Schiff and Galicia does not expressly

disclose the inside mirror part and the outside mirror part are on different planes that are parallel to each other. However, Hou teaches a rearview mirror arrangement with a second mirror (62) offset but substantially parallel to a first rearview mirror (52) where the second mirror is extendable to increase the rearward view (figs. 2 and 4). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the proposed combination of Schiff and Galicia with an additional offset but parallel mirror to the outside mirror to achieve the claimed invention because all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950).

Response to Arguments

Applicant's arguments filed 08/27/2008 have been fully considered but they are not persuasive.

In response to applicant's argument that minor differences between the references, it is noted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what

the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that the Galicia reference teaches away from the proposed combination, the examiner recognizes that a prior art reference must be considered in its entirety, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). See also MPEP § 2123.

In response to applicant's argument that Galicia provides not teach of a height above the driver's view point position, it is noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, it meets the claim. While features of an apparatus may be recited either structurally or functionally, claims directed to a product must be distinguished from the prior art in terms of structure rather than function. See *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). The combined teachings of Schiff and Galicia certainly demonstrate that the mirror arrangement of Schiff is capable of being disposed at a height above the driver's view point position and, therefore, meet the claimed limitations.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Consilvio whose telephone number is (571) 272-2453. The examiner can normally be reached on Monday thru Thursday, 8:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on (571) 272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/M. C./
Examiner, Art Unit 2872

/Alessandro Amari/
Primary Examiner, Art Unit 2872